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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,057	10/30/2003	Glenn Park	03GP-1-1	8127

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EXAMINER

SAGER, MARK ALAN

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,057	<b>Applicant(s)</b> PARK, GLENN	
	<b>Examiner</b> M. A. Sager	<b>Art Unit</b> 3713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/425523 in view of Burke (2002/016848). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to eliminate attachable to a body of a golfer of Park’s training device ‘523 so as not to be limited the form of use where its patentability is not contingent upon its environment of use. Burke discloses a device teaching use in form either attachable on golfer (fig. 7) or sport implement such as golf club/grip (fig. 1-5) and a sound generating assembly (ref 22). Therefore, it would have been obvious to an artisan to remove attachable to a body of a golfer from Park’s claims so as to not limit its form of use where patentability is not contingent thereon which secures broader patent protection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 9-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/425523 in view of Burke as applied to claims above, and further in view of Conley (5082283). Although the conflicting claims are not identical, they are not patentably distinct from each other because although Park '523 claims the training device is attachable to the golfer, Burke and Conley each teach that environment of use may include sport implement like a golf club such as at its grip. Using the training device on a player may be disruptive to the user and thus by placing the device within the implement it is unobtrusive and not disruptive to user's operation. Therefore, it would have been obvious to an artisan at a time prior to the invention to add within a hand-grip portion of a golf club as suggested by either Burke or Conley to Park's device 523 so as to place the device in the sport implement so as to be unobtrusive or not disruptive to user's operation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 3-9 are rejected under 35 U.S.C. 102(b) as anticipated by Sabowitz (5558519) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sabowitz in view of Fulford (5959230). Where a programmable audible output produces physical vibration patterns at least due to sound wave producing vibrations, Sabowitz discloses a golf training aid (ref 10) for assisting a golfer in swinging a golf club with a preferred consistent tempo (figs 3-6) teaching a case (ref 12) attachable to a body (ref 23-24) and means within the case for generating low level physical vibration patterns of adjustable time duration (ref 20-22) for sensing by the golfer (ref. 15, 18b) as a preferred swing tempo for a golf club (4:18-57), user programmable means (ref 20-22), visual display means where an array of one LED is responsive to the user programmable means for visually displaying preferred swing tempo (5:7-12, ref 17), user operable means for activating array or means for generating the vibration patterns (ref 13-14), where means for

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generating vibration patterns comprises electromechanical means including a motor (4:3-6).

Sabowitz states beat counting device may include internal electronic circuitry such as employed in conventional electronic metronomes; Fulford at 1: 18-22 is provided as evidence only that electronic metronomes include electronic circuitry to drive a motor. Thus, Sabowitz includes a motor. Further regarding claim 4, Sabowitz display (ref 17) is either an array of light or is equivalent to claimed array of lights for performing same function with same structure in that a light is visually signaling the tempo set by user. Alternatively, it would have been obvious to a user to duplicate Sabowitz display (ref 17) and its function so as to produce an array of lights providing visual output of the tempo set by user. *In re Hazra*, 124 USPQ 378

Alternatively, where an audible output as produced by Sabowitz' device does not produce vibration patterns, producing audible output may be distracting or annoying to others in environment where a user of Sabowitz device is used such as on a golf course or golf practice/driving field, the use of the earphones may be distracting to the user of Sabowitz device (some users do not like ear phones), or the user of Sabowitz device may be hearing impaired and thus an audible output provides no or little aid. However, paging devices are by OFFICIAL NOTICE notoriously well known and have been in public use for twenty years. These devices receive paging messages from others sending a paging message. Pagers generally provide at least two forms of output to notify user of an incoming message where the output included audible or tactile or both simultaneously which was set by user of the pager and the tactile notification generally was set so as to not distract or annoy others or was set for those users that had impaired hearing. Presently, by OFFICIAL NOTICE cellular phones also may have the same two mode settings of audible or tactile or both simultaneous. Similarly to pager or cellular

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phone device use that include an audible mode and a tactile mode for instances where a user may switch between audible output or vibratory signaling in situations which may warrant privacy of signal receipt so as not to distract or annoy others nearby, there are situations where use of audible output on a golf course or golf driving range may be disruptive to others nearby, but use of tactile output would not annoy or distract others nearby or would provide a sensory output discernable for those with impaired hearing. Fulford discloses a tactile tempo indicating device that provides a tactile pulse to user including a user that may be hearing impaired without distracting or annoying those nearby (1:39-60). Therefore, it would have been obvious to an artisan at a time prior to the invention to add means for generating low level physical vibration patterns of adjustable time duration for sensing by user as suggested by notoriously well known two mode switchable notification of pager or cellular phones and Fulford to Sabowitz device so as to not annoy or distract others nearby or to allow a user who may be hearing impaired to utilize golf training method of distinct metered constant rhythm as an aid to improve smooth well timed swing (2:10-58, 3:10-12).

8. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (2002/0160848) in view of Tuer (2002/0077189) and Conley (5082283). Burke (paragraphs 23, 27, 30, 32, 34, 38, 40, 42) discloses a device including a housing (fig 1-2), sound generation assembly (ref 22), user programmable means (ref 64), display means (ref 86) where its environment of use (sic) including the housing being either attachable to a user (fig. 7) or within hand-grip portion of a golf club (figs. 1-2), but lacks vibration generating means, as particularly claimed. Tuer discloses a device suggesting attaching device to a sport implement and including visual display graphics, sound interface, tactile device and vibratory device, but it suggests such

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device in the shaft. Conley discloses a trainer teaching a tactile signaling device such as a vibrator or a tactile signal generator such as a vibrating device consisting of a motor (3:65-67, 4:51-56) for tactile feedback in the grip-portion of a club. Therefore, it would have been obvious to an artisan at a time prior to the invention to add vibration generation means, housing is within a hand-grip portion of a golf club as suggested/taught by Tuer and Conley to Burke's device to provide tactile feedback of an overswing condition so as to not be disruptive to either golfers nearby (sound may be disruptive to others nearby user of training device, discussion above regarding disruption of golfers at course or driving range incorporated herein) or user (device on user may be annoying or disruptive to user of device, discussion above regarding device on user being disruptive is incorporated herein) while providing real time feedback of swing.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ervin discloses a swing exerciser that includes electromechanical devices such as a metronome to assist in synchronizing the users movements (paragraph 50) and includes a wearable component (fig 19). Amato discloses a club shaft having vibratory means. Burke '167 discloses golf overswing alerting mechanism.

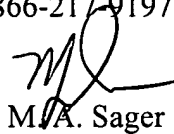
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M.A. Sager  
Primary Examiner  
Art Unit 3713

MAS